UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,913	05/09/2006	Akihiro Tanaka	2006_0620A	4446

52349   7590   01/12/2010
WENDEROTH, LIND & PONACK L.L.P.
1030 15th Street, N.W.
Suite 400 East
Washington, DC 20005-1503

EXAMINER
KHAN, ASHER R

ART UNIT	PAPER NUMBER
2621	

MAIL DATE	DELIVERY MODE
01/12/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/578,913	TANAKA ET AL.
	Examiner	Art Unit	
	ASHER KHAN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>7/8/2009</u>.

2a) ☒ This action is FINAL.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-23</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-23</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>09 May 2006</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☒ All b) ☐ Some * c) ☐ None of:

　　　　1. ☒ Certified copies of the priority documents have been received.

　　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claim 18 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subcombination, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/27/2009.

Applicant's election without traverse of 1-17, 19-22, 24, 25 and 27 in the reply filed on 10/27/2009 is acknowledged.

Response to Arguments

Applicant's arguments filed 07/08/2009 have been fully considered but they are not persuasive.

In re page 17 applicants argues that Terada fails to disclose Terada discloses a content reproduction device that reproduces a stream media content that is linked to from a multimedia content written in markup language used for web browsing, wherein a state of the reproduction of the stream media content can be changed according to an instruction by a user and the reproduction of the stream media content is performed for a predetermined consecutive period of time, the content reproduction device comprising:

a display unit operable to display the multimedia content (a reproducing unit operable to reproduce the stream media content that is linked to from displayed multimedia content; a reproduction state change accepting unit operable to accept, from the user, reproduction state change information indicating a change in the state of the reproduction state of the stream media content by the reproduction unit.

In response the Examiner respectfully disagrees. Terada discloses Terada discloses a content reproduction device that reproduces a stream media content (Col. 9 lines 1-15; Fig. 3) that is linked to from a multimedia content (Fig. 2) written in markup language (Col. 1 lines 30-40; Col. 8 lines 20-39; world wide web servers are used to host sites or websites which contain web pages which are written in markup language. While URLs are addresses to connect the host sites) used for web browsing, wherein a state of the reproduction of the stream media content can be changed according to an instruction by a user and the reproduction of the stream media content is performed for a predetermined consecutive period of time, the content reproduction device comprising:

a display unit operable to display the multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines 1-3)

a reproducing unit operable to reproduce the stream media content that is linked to from displayed multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines 1-3);

a reproduction state change accepting unit operable to accept, from the user, reproduction state change information indicating a change in the state of the reproduction state of the stream media content by the reproduction unit(Col. 3, lines 51-55; reproduction change to fast forward or rewind of a content being currently reproduced).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specification does not disclose "a return position determining unit operable to determine, based on the reproduction state change information and based on whether (i) all of the stream media content has been reproduced by the reproducing unit or (ii) only a portion of the stream media content has been reproduced by the reproducing unit a return position indicating a portion of the multimedia content to be displayed when transitioning from reproducing the stream media content back to displaying the multimedia content when the reproduction of the stream media content by the reproducing unit has ended, wherein the display unit is operable to display the portion of the multimedia content indicated by the return position". Specification only discloses "a return position determining unit which determines, according to the reproduction state change information accepted by the reproduction state change accepting unit, a return position in the multimedia content for a transition after the reproduction of the stream media content is ended, wherein the display unit displays the multimedia content located in the determined return position" in paragraph 0006 of published application.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

2.   **Claim 1-6, 7-9, 11-15, 17 and 19-23 are rejected under 35 U.S.C. 102(e) as**

being anticipated by U.S. Patent 7,113,983 B1 to Terada et al "Terada".

As to claims 1, 19 and 21, Terada discloses a content reproduction device that

reproduces a stream media content (Col. 9 lines 1-15; Fig. 3) that is linked to from a

multimedia content (Fig. 2) written in markup language (Col. 1 lines 30-40; Col. 8 lines

20-39; world wide web servers are used to host sites or websites which contain web

pages which are written in markup language. While URLs are addresses to connect the

host sites) used for web browsing, wherein a state of the reproduction of the stream

media content can be changed according to an instruction by a user and the

reproduction of the stream media content is performed for a predetermined consecutive

period of time, the content reproduction device comprising:

 a display unit operable to display the multimedia content (Fig. 4; Col. 8 lines 20-39; Col.

9 lines 41-67, Col. 10 lines 1-3)

a reproducing unit operable to reproduce the stream media content that is linked to from

displayed multimedia content (Fig. 4; Col. 8 lines 20-39; Col. 9 lines 41-67, Col. 10 lines

1-3);

a reproduction state change accepting unit operable to accept, from the user,

reproduction state change information indicating a change in the state of the

reproduction state of the stream media content by the reproduction unit(Col. 3, lines 51-

55; reproduction change to fast forward or rewind of a content being currently

reproduced); and

a return position determining unit operable to determine, according to the reproduction

state change information accepted by said reproduction state change accepting unit

(Change from normal reproduction to Fast forward or Fast rewind), a return position

(URL for the content) in the multimedia content for a transition after the reproduction of

the stream media content is ended (client device acquires another content that

precedes or follows and reproduces contents and ends reproduction of currently

reproduced by fast forwarding or reversing), wherein said display unit is operable to

display the multimedia content located in the determined return position (Figs. 3, 6a-

6c;Col. 3, lines 50-67;Col. 4, lines 1-3; Col. 11 lines 31-52).

        As to claims 2, 20 and 22, Terada discloses everything claimed as applied in

claim 1 above. In addition Terada discloses wherein the return position determining unit

is operable to obtain a transition condition table (program file, Fig. 3) describing a

relationship between the state of the reproduction of the stream media content

(preceding or following contents are being fast forwarded or fast rewound or currently

played) and the return position (content URL), and to determine the return position

(content URL) based on the transition condition table and the reproduction state change

information (Fig. 3;Col. 12, line 47-60).

As to claim 3, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses comprising a storing unit in which the multimedia content (Fig. 3, program file with contents), the stream media content (Fig. 3, contents), e transition condition table (Program file) and accepted reproduction state change information (Command of fast forward is given and is thus accepted and stored) are stored, wherein the reproducing unit is operable to reproduce the stored stream media content, wherein the display unit is operable to display the stored multimedia content, and wherein the return position determining unit is operable to determine the return position based on the stored transition condition table and the stored reproduction state change information (Figs. 3;Col. 3, lines 50-67;Col. 4, lines 1-3).

As to claim 4, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, further comprising a receiving unit operable to receive, from a server via a network (Fig. 1), the multimedia content, the stream media content and the transition condition table, wherein the reproducing unit is operable to reproduce the received stream media content, where in the display unit (Fig. 5) is operable to display the received multimedia content, and wherein the return position determining unit is operable to determine the return position based on the received transition condition table and the accepted reproduction state change information (Figs. 3;Col. 3, lines 50-67;Col. 4, lines 1-3).

As to claim 5, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the return position includes at least two different URLs (Figs. 3 and 8).

As to claim 6, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses, wherein the reproduction state change information includes at least one of, stop or fast-forward, rewind and pause as the change in the state of the reproduction (Col. 3 lines 50-67; Col. 16 lines 49-67 and col. 17 lines 1-2), and includes time information indicating a time when the change in the state of the reproduction is made (Fig. 8, reproduction timing), and wherein the return position determining unit is operable to determine, with reference to the state of the reproduction that corresponds to the time information, the return position based on whether or not a transition condition described in the transition condition table is satisfied (Col. 3 line 50-67).

As to claim 8, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein at least a first content and a second content are included in the multimedia content to be displayed by the display unit after the reproduction of the stream media content has ended, and wherein the display unit is operable (a) to display the first content in a case when the reproduction state change information is accepted before (execution of fast forward or fast reverse) the reproduction of the stream media content has ended, and (b) to display the second content in the case where the reproduction state change information is not accepted until the reproduction of the stream media content has ended (Col. 3 line 40-67 and Col. 1-3, following it true when Program file (Multi media content) includes currently played (second content) and preceding or following contents (first content) until the execution of fast forward or fast reverse).

As to claim 9, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the display unit is operable (a) to display the first content (preceding or following content) in a case when the reproduction state change information includes one of fast-forward and stop, and (b) to display the second content (currently played content) in a case when the reproduction state change information includes neither of fast-forward and stop (Col. 3 line 40-67 and Col. 1-3).

As to claim 11, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses further comprising a reading unit operable to read, via a storage medium (cache), at least one of the stream media content (content), the multimedia content (program), and the transition condition table (program file) (Figs. 1 and 3).

As to claim 12, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein upon receiving the reproduction state change information (reproduction change to fast forward or reverse) from the reproduction state change accepting unit and changing then state of the reproduction, the reproducing unit is operable to notify the return position determining unit of the reproduction state change information, and after the reproduction of the stream media content is ended, , the return position determining unit is operable to determine the return position based on the reproduction state change information (Col. 3, line 49-67; reproduction of preceding or following content after ending reproduction of currently reproduced content).

As to claim 13, Terada discloses everything claimed as applied in claim 1 above. In addition Terada discloses wherein the return position determining unit holds a state of

the reproduction that changes each time the reproduction state change information is

received from the reproducing unit, and is operable to determine the return position

based on the state of the reproduction after the reproduction of the stream media

content has ended(each time program file is changed new content with their

corresponding URL are provided; Col. 2 line 43-67 and Col. 3 line 1 -20).

As to claim 14, Terada discloses everything claimed as applied in claim 1 above.

In addition Terada discloses wherein the display unit holds a state of the reproduction

that (reproduction of contents currently reproduced and following contents if a fast

forward command is issued) changes each time the reproduction state change

information (fast forward or fast reverse command) is received from the reproducing

unit, and wherein after the reproduction of the stream media content is ended, the

display unit is operable to determine the return position according to the state of the

reproduction and notify the return position determining unit of the return position

(reproduction of following program instead of currently reproduced; Col. 12, lines 46-63;

Figs. 6b and 6c).

As to claim 15, Terada discloses everything claimed as applied in claim 1 above.

In addition Terada discloses wherein the reproducing unit holds a state of the

reproduction that changes each time the state of reproducing the stream media content

is changed (fast forwarding of currently reproduced contents and reproduction of

following contents), and is operable, after the reproduction of the stream media content

has ended, to determine the return position according to the state of the reproduction (if

fast forward reproduce following contents), and to notify the return position determining

unit of the return position (URL of following contents)(Col. 12, lines 46-63; Figs. 6b and

6c).

As to claim 17, Terada discloses everything claimed as applied in claim 1 above.

In addition Terada discloses wherein the return position determining unit is operable to

(a) determine a screen for exempting charging, as the return position of the multimedia

content, in a case when the reproduction state change information is not found until

the reproduction of the stream media content has ended, and determine a screen for

charging, as the return position of the multimedia content, in a case when the

reproduction state change information change information is found until the reproduction

of the stream media content is ended (Fig. 5, shows screen for purchasing contents and

delivering of the contents purchased).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.**

Patent 7,113,983 B1 to Terada et al "Terada" in view of Official notice.

As to claim 7, Terada discloses everything claimed as applied in claim 1 above.

But Terada does not expressly disclose wherein the return position determining unit is

operable to determine, as the return position, a default return position that is previously

determined in a case when the return position corresponding to the reproduction state

change information is not described in the transition condition table. However official

notice is taken of the fact that it would have been obvious to one skill in the art to

provide a default value for a return position when it is not described in the transition

condition table. It is very well known in the art to provide default values if some values

are not input or not present. Therefore it would have been obvious to one skilled in the

art at the time of invention to have been motivated to have a default value incase of the

return position is not described.

5.   Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent 7,113,983 B1 to Terada et al "Terada" in view of U.S. Patent

5,956,037 to Osawa et al. "Osawa"

        As to claim 10, Terada discloses everything claimed as applied in claim 1 above.

In addition Terada discloses the ending of reproduction of multi media content and a

return position determining unit to determine the return position (Figs. 6a-6c) .But

Terada does not expressly, further comprising a reproduction history storing unit that

holds a history of the reproduction state change information, wherein upon receiving the

reproduction state change information from the reproduction state change accepting

unit and changing the state of the reproduction, the reproducing unit is operable to notify

the reproduction history storing unit of the reproduction state change information, and to

read the history of the reproduction state change information held in the reproduction

history storing unit.

        Osawa further discloses comprising a reproduction history storing unit which

holds a history of the reproduction state change information (Fig. 1b; col. 2 line 26-29),

wherein upon receiving the reproduction state change information from the reproduction
state change accepting unit (Fig. 6, 601) and changing the state of the reproduction, the
reproducing unit is operable to notify the reproduction history storing unit of the
reproduction state change information, and to read the history of the reproduction state
change information held in the reproduction history storing unit (Col. 12 lines 35-55; Col.
13 lines 27-42; Fig. 6).

At the time of invention, it would have been obvious to a person of ordinary skill
in the art to combine Terada with the teachings of Osawa. Motivation to combine would
have been to provide a history of contents so that appropriate return position of contents
can be achieved so that the appropriate contents according to the return position could
be played.

As to claim 16, Terada discloses everything claimed as applied in claim 1 above.
In addition Terada discloses, wherein, after the reproduction of the stream media
content has ended(client device acquires another content that precedes or follows
currently reproduced contents if a fast forward command is issued by a user), one of the
display unit and the reproducing unit is operable to read the state of the reproduction
(display unit and reproducing unit reproduces and for example fast forwards) and, to
determine the return position, and to notify the return position determining unit of the
return position (Col. 12, lines 47-61). However Terada does not expressly disclose a
history of the reproduction state change information held in the reproduction history
storing unit.

Osawa discloses a history of the reproduction state change information held in the reproduction history storing unit (fig. 1B, 105' or Fig. 6)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Terada with the teachings of Osawa. Motivation to combine would have been providing a unit that holds history of operation performed by a user so that an appropriate location of reproduction could be determined.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks- Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/A. K./
Examiner, Art Unit 2621